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Attorney Docket No. 31735/70009
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael R. DUFF et al. Conf. No.: 8141
Serial No.: 10/645,844 Art Unit: 1615
Filed: August 22, 2003 Examiner: Ghali, Isis A. D.
For: METHOD AND APPARATUS FOR DECREASING THE
DROWSINESS OF AN INDIVIDUAL

RESPONSE TO 27 MAY 2004 OFFICE ACTION

Box Non-Fee Amendments
Honorable Commissioner for
Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the office action mailed May 27, 2004.

The restriction requirement.

Applicant's petition of the April 16, 2004 requirement accompanies this response.

Applicant urges that the restriction is not proper and should be withdrawn. Action on all of applicant's claims (Nos. 41-50) is requested.

The rejection under 35 U.S.C. 112, first paragraph.

Claim 43 is rejected as failing to comply with the written description requirement in that “[t]he claim recites new matter that was not disclosed in the specification as originally filed and that is the step of contacting one finger or the thumb of the individual with the saturated towlette.”

The drawing at Fig. 5 shows towelette 10 with the index finger and thumb in contact with substance containing portion 14. The specification at page 5 describes what is shown in Fig. 5.

The specification at page 3, the paragraph beginning on line 18, states "there is provided an apparatus for contacting the skin of an individual so as to decrease the drowsiness of the individual. The apparatus includes a towelette impregnated, meaning "saturated" as per Webster's New College Dictionary, with a stimulating organic substance...."

Accordingly, the step of contacting one finger or the thumb of the individual with the saturated towlette is provided in applicant's disclosure.

The rejection under 35 U.S.C. 103(a).

The office action at page 4 rejects claim 43 over Furman in view of Merck Index. Furman is relied on for teaching a coolant composition and it is acknowledged that Furman "does not teach the ammonia containing substance." Merck Index is asserted to teach that ammonia causes irritation of the eye, nose and throat. It is concluded "it would have been obvious... to deliver the tissue impregnated with an stimulating organic substance as disclosed by Furman, and add ammonia to the composition motivated by the teaching of Merck Index...."

Furman is not a teaching or suggestion of the steps of applicant's invention as recited in claim 43. Claim 43 requires the step of providing a towelette saturated with an amount of liquid stimulating organic substance and an amount of ammonia containing substance. Furman describes the active cooling compound can be incorporated in cleansing tissues (column 6, lines 33-45), but this is not the "providing" step of applicant's claim 43. The suggestion in the office action that it would have been obvious to add ammonia as suggested by Merck Index does not appear to be proper. Merck Index has not been cited in the office action and a copy has not been provided with the office action. Citation of the portion of Merck Index relied on is requested and a copy of the citation is requested so that applicant can better evaluate what is taught and/or suggested.

The claim 43 step of providing a towelette saturated with an amount of liquid stimulating organic substance and an amount of ammonia containing substance is further limited to the ammonia containing substance comprising .25% to 5% ammonia by weight. The office action does not rely on Furman or Merck Index for a teaching or suggestion of this limitation.

Accordingly, claim 43 avoids the relied on prior art.

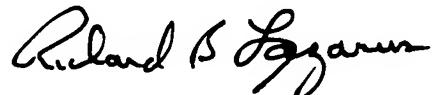
Claim 43 also recites contacting at least one finger or thumb of an individual with the saturated towelette... and contacting at least one of the face and neck skin of an individual with the saturated towelette.... The first contacting step states "to stimulate nerve endings in the contacted area of the skin" and the second contacting step is stated to "a) stimulate nerve endings in the contacted area of the skin, and b) provide olfactory stimulation resulting from vapors...." Furman does not disclose these steps and Merck Index is not cited for a teaching or suggestion of these steps.

For all of the above reasons, the steps of claim 43 are not taught or suggested by the prior art. Allowance of claim 43 is, respectfully, requested.

The examiner is invited to telephone the undersigned to discuss any issue(s) so as to expedite resolution of any remaining issues.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (31735/70009).

Respectfully submitted,
BARNES & THORNBURG



Richard B. Lazarus
Registration No. 48,215
(202) 289-1313